

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow.

Claims 11, 13, and 28 are currently being amended.

Claims 29-35 are being added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-35 are now pending in this application.

Related Application

U.S. Patent Application 09/915,671 is based on a similar description as the present application, but is directed to alternate aspects of the application. U.S. Patent Application 09/915,671 is being handled by Roderick D. Bradford in the same art unit as the present application. An IDS has been filed with this reply.

Rejection of Claims 11 and 13 under 35 U.S.C. § 112, second paragraph

In section 1 of the Office Action, Claims 11 and 13 were rejected under 35 U.S.C. § 112, second paragraph for using the terms “a key” and “a user”. Claims 11 and 13 have been amended to recite “the key” and “the user”, and are believed to overcome the rejection.

Rejection of Claims 1, 3, 15, 16, 18-20, and 24-28 over Selker et al. in view of Nakamura

In section 3 of the Office Action, Claims 1, 3, 15, 16, 18-20, and 24-28 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,501,229 to Selker et al. in view of U.S. Patent No. 6,380,921 to Nakamura.

The invention must be treated as a whole, and neither reference, nor the combination of references, addresses the considerations underlying the claimed invention or the problem to be solved, when the claimed invention is treated as a whole. See MPEP 2141.02. Where less than every element of the claims is shown in the prior art, the invention must be treated as a whole to determine whether it would have been obvious to make the invention. Designing a light source for a medical device brings up special considerations, as discussed below. These considerations are not addressed by Selker et al. or by Nakamura. Additionally, the motivation behind including the illumination timer (15) in Nakamura is not believed to be found in exercise stress systems, the technology that prompted the present claimed invention. Thus, the claimed invention as a whole is not rendered obvious by Selker et al. in view of Nakamura.

As discussed in the present application in paragraph [0006], the particular embodiment described in the detailed description arose in the context of the growing trend to ~~run EKG and echo stress tests in the same location, one after the other.~~ This posed the new problem for the physician that operated the EKG that he could not read the results of the test, which are printed on a medium which moves across a work surface. As described in the present application, an LED light source was added to the EKG instrument to aid the physician. It was soon realized that, for a light meeting the requirements of paragraph [0024] of the present application, when the lights in the room came back on, as they would when the echo stress test was complete, it was difficult to identify that the light was on, which could result in the LED being left on indefinitely. This would have adverse effects on the life of the LED. When designing a medical device that is used in a room which is temporarily dark, the designer must balance the need to preserve the life of the light source, and its risk of being left on, with the need to provide light for the entirety of the time that a clinician will be using the device. In some instances, a clinician running one of these joint exercise stress tests may need the aid of the light source for extended periods of time (typically up to twenty minutes, sometimes longer, but unlikely for more than one hour) without ever hitting a key of a work station.

These considerations are never addressed by Selker et al. or by Nakamura. Selker et al. does not even recognize the need for a light source. Further, Nakamura does not recognize

the special needs of a clinician using a medical instrument including the extended periods of non-use of the keypad, and is, on the other hand, directed to problems relating to excessive power consumption of a battery of a notebook computer.

Not only are the considerations underlying the present application not addressed or suggested by either of the references, the motivation to include the timer of Nakamura is not relevant to the problem addressed by the present application. The relevant section of Nakamura is directed to saving the limited power supply of a notebook computer battery. See Col. 4, lines 13-16; Col. 5, lines 53-57; and the Office Action at page 4. It would be an odd occurrence for an exercise stress test instrument to be primarily powered by a battery, since the other exercise stress equipment (the treadmill, etc) is generally not easily portable (thus, exercise stress test instruments are typically not designed to be portable). Further, the applicant can not currently recall an exercise stress testing system primarily powered by a battery, let alone one that is prior art to the claimed invention. Thus, someone looking to solve the problems particular to exercise stress systems would not look to Nakamura, because exercise stress systems (the technology in which the problems addressed by the present application have arisen) do not possess the concerns which motivate Nakamura.

Thus, when taking a look at the invention as a whole, the fact that neither reference teaches or suggests the considerations underlying the invention addressed in the application which is claimed in the claims, and the fact that the motivation for including the illumination timer (15) in Nakamura would not be a consideration underlying the invention claimed in the claims, show that the claimed invention, as a whole, is not rendered obvious by Selker et al. in view of Nakamura. Therefore, Claims 1, 3, 15, 16, 18-20, and 24-28 are believed to be in condition for allowance.

Rejection of Claims 2, 4, and 17 over Selker et al., Nakamura, and Polley

In section 4 of the Office Action, Claims 2, 4, and 17 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,501,229 to Selker et al. in view of U.S. Patent No. 6,380,921 to Nakamura, and further in view of U.S. Patent No. 5,868,487 to Polley et al.

Polley et al. does not help correct the deficiency found in the combination of Selker et al. and Nakamura in light of an analysis of the invention as a whole. Thus, Selker et al. in view Nakamura, and further in view of Polley et al. would not render the claims obvious. Claims 2, 4, and 17 are believed to be in condition for allowance.

Rejection of Claims 5-14, 22, and 23 over Selker et al., Nakamura, and Nelms et al.

In section 5 of the Office Action, Claims 5-14, 22, and 23 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,501,229 to Selker et al. in view of U.S. Patent No. 6,380,921 to Nakamura, and further in view of U.S. Patent No. 4,365,290 to Nelms et al.

Nelms et al. does not help correct the deficiency found in the combination of Selker et al. and Nakamura in light of an analysis of the invention as a whole. Thus, Selker et al. in view Nakamura, and further in view of Nelms et al. would not render the claims obvious. Claims-5-14, 22, and 23 are believed to be in condition for allowance.

Rejection of Claim 21 over Selker et al., Nakamura, and Gallant et al.

In section 6 of the Office Action, Claim 21 was rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,501,229 to Selker et al. in view of U.S. Patent No. 6,380,921 to Nakamura, and further in view of U.S. Patent No. 4,316,249 to Gallant et al.

Gallant et al. does not help correct the deficiency found in the combination of Selker et al. and Nakamura in light of an analysis of the invention as a whole. Thus, Selker et al. in view Nakamura, and further in view of Gallant et al. would not render the claims obvious. Claim 21 is believed to be in condition for allowance.

Objection to the Drawings

In section 7 of the Office Action, Figure 1 was objected to because reference numeral 40 appeared twice and reference numeral 42 did not appear. Applicants amended Figure 1 by a preliminary amendment submitted on November 8, 2001 to correct the issue highlighted by

the examiner. The leftmost numeral 40 was changed to 42 by the amendment. A copy of the amended drawing is attached.

Objection to the Specification

In section 8 of the Office Action, the specification was objected to due to informalities appearing in the specification (i.e. the presence of mis-numbered terms). It is believed that the amendments to the specification that were made in the preliminary amendment discussed above overcome the objection. A copy of the preliminary amendment is attached.

New Claims 29-31

New Claims 29-31 are supported by the original specification at Claims 1 and 2, at paragraphs [0012] and [0023], and Figure 1.

Claim 29 recites elements similar to those in Claim 1 and is believed to be allowable for reasons similar to those discussed in the remarks above. Further, Claim 29 is more specifically limited to exercise stress systems

New Claims 32-35

New Claims 32-35 are supported in the original specification at Claim 8, at paragraphs [0012], [0017] and [0034-38], and Figures 1 and 6.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment,

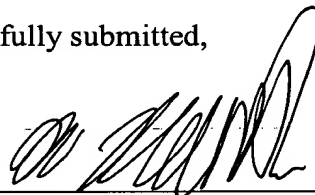
to Deposit Account No. 50-2401. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-2401. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-2401.

Respectfully submitted,

Date

Aug 4, 2003

By



FOLEY & LARDNER

Customer Number: 33679



33679

-PATENT TRADEMARK OFFICE-

Telephone: (414) 297-5839

Facsimile: (414) 297-4900

Marcus A. Burch

Attorney for Applicant

Registration No. 52,673